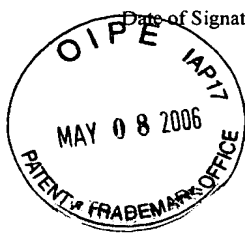


I hereby certify that this correspondence is being deposited with the United States Postal Service on the date set forth below as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450.

Date of Signature and Deposit: May 4, 2006

Sara D. Vinakov

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark McCormick
Gary Barrett
Roland Green
Jaz Singh

Date: May 4, 2006

Serial No.: 10/675,329

Art Unit: 1639

Filed: 09/30/2003

Examiner: My Chau T Tran

For: MICROARRAYS WITH VISUAL
ALIGNMENT MARKS

Docket: 700706.90181

RESPONSE TO RESTRICTION REQUIREMENT AND ELECTION OF SPECIES

Mail Stop Amendment
Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In an Office Action mailed March 20, 2006, the Examiner in charge of the above-noted application imposed a requirement for restriction dividing the claims into three groups, which in the Examiner's opinion are not related. The Examiner also requests an election of species.

In response, applicants provisionally elect the invention of Group II, Claims 7-13, drawn to a method for making a microarray. Since Group II is provisionally elected, applicants are also required under 35 U.S.C. 121 to elect a single disclosed species of a hapten and a reporter molecule. In response, applicants elect biotin as the hapten and horseradish peroxidase as the reporter molecule, with traverse. As such, Claims 7-13 read on the elected species. This election is made with traverse and without prejudice to the eventual filing of a divisional application and rejoinder of any of the non-elected groups (Groups I and III) back into the application.

Applicants submit that the restriction is traversed on the grounds that the subject matter of all of the Groups I-III are inextricably linked. In particular, the invention of Group I (microarray) and Group II (process for making the microarray) are related as a process of making and the product made because the process of making the microarray as claimed in Claim 7 is used to make the microarray of Claim 1. The claimed method of making the microarray by

Application No.: 10/675,329
Response Dated: May 4, 2006
Reply to Office Action Dated: March 20, 2006


synthesizing the probe sets and depositing the alignment marks between the subarrays on the microarray using the same array synthesizer cannot be used to make another or materially different microarray. Also, applicants submit that the claimed microarray is not made by another or materially different process because the building of the probe set and the deposition of the alignment marks are performed by the same array synthesizer described in the specification.

Applicants believe that a proper search for one group of claims would inevitably overlap with that for the others and the search results for one is relevant to the others. Applicants do not believe that a burden exists for searching more than one of the patentably related groups. Applicants also wish to note that procedurally restriction requirements are optional in all cases (see MPEP § 803). If the search and examination of a claim set can be made without serious burden, the Examiner must examine the claims on the merits, even though they may be arguably directed at distinct or independent inventions (MPEP § 803). In the present application, and as described hereinabove, it is respectfully submitted that claims in Groups I-III can be examined together without serious burden on the Office. Accordingly, it will be unnecessarily burdensome on both the applicants and the Office to consider this highly related subject matter in several separate patent applications.

For these reasons, applicants respectfully request that the restriction requirement on Groups I-III be reconsidered and withdrawn. Wherefore examination on the merits is respectfully requested.

A petition for a one month extension of time accompanies this response so that the response will be deemed to have been timely filed. Should any other extension of time be due, please consider this to be a request for the appropriate extension of time and a request to charge the fee due to the Deposit Account No. 17-0055. Likewise, no other fee is believed due, but should any other fee be due, in this or any subsequent application, please consider this to be a request to charge the fee to the same deposit account.

Respectfully submitted,



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